



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/734,979
Filing Date: December 10, 2003
Applicant: Donald H. Campbell and David R. Hay
Group Art Unit: 1762
Examiner: David F. Turocy
Title: BLOCKED ISOCYANATES FOR CLEARCOATS
WITHOUT USAGE RESTRICTIONS
Attorney Docket: IN-5567
Harness, Dickey & Pierce Docket No. 906-339

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 C.F.R. § 41.41

Sir:

This is Appellants' reply to the Examiner's Answer mailed April 25, 2006. This
Reply is due June 25, 2006

Reply to Examiner's Arguments

Claims 1-14 are patentable over Sadvary et al., U.S. Patent Application Publication 2001/0039324 A1.

Appellants have argued that their claimed invention is patentable because their claimed method of coating a substrate offers an unexpected advantage over the generally known prior method genus. The Sadvary publication discloses curing agents for its polysiloxane coatings that include aminoplasts, polyisocyanates, triazines, polyepoxides, polyacids, and polyols. Page 4, para. 41. Among these, triazines such as the tricarbamoyl triazine compounds as described in the Jacobs, III patent can be included. Page 4, para. 48. The Jacobs, III tricarbamoyl triazine compounds include those with blocking groups of X-R, in which X can be nitrogen, oxygen, sulfur, phosphorus, or carbon and R "is lower alkyl, preferably C₁-C₈ and especially methyl, ethyl, n-propyl, i-propyl, butyl, n-octyl, 2-ethylhexyl, or a mixture of any of the foregoing." The Jacobs patent thus does not have a clue about different efficacies of its tricarbamoyl triazine compounds in Appellants' claimed method. Neither the Sadvary publication nor the Jacobs, III patent provides any direction for selecting compounds that can be recovered from wastewater. Further, the only commercial tricarbamoyl triazine compound, methanol/butanol blocked melamine triisocyanurate (one of the Jacobs, III preferred X-R combinations), is unusable in the US because of aquatic toxicity.

Thus, at the time of Appellants' invention, it was unknown how or even if one could use triazine esters in a spray coating method.

A prima facie showing of obviousness may be overcome by a showing of unexpected results. In one type of unexpected results, a species is found to possess a different feature or utility over a generally known genus, so that the species is patentable over the known, broad genus. Thus, claims that are limited to the unexpected difference of the species are patentable

over a disclosure of the genus that provides no suggestion or disclosure that can successfully lead to the selection of the claimed species. *In re Deuel*, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995).

Appellants submit that the claimed coating method for maximizing capture of a tricarbamoyl triazine compound from wastewater is unexpected and could not have been predicted from what was known beforehand. The Sandvary document discusses the Jacobs, III compounds as useful adjuvant curing agents, paragraph 48, but the Jacobs, III compounds in general cannot be used in spray coatings in the US because of unacceptable aquatic toxicity. The Jacobs, III patent teaches preferred compounds have blocking groups XR that can have, in any combination for the three blocking groups, X as nitrogen, oxygen, sulfur, phosphorous, or carbon, and R as preferably C₁-C₈. Only a few of these combinations can avoid the aquatic toxicity problem, and there is no way to tell from the Sandvary and Jacobs, III documents which those few may be.

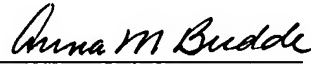
It is long-settled law that the patentability of the invention as a whole must be considered, that a showing of knowledge of individual components per se of the invention is not sufficient to negative patentability. The Examiner argues that Jacobs “anticipates” compounds included in claim 1, Examiner’s Answer, page 7, but this is a Appellants respond that the claims are not directed to compounds, but to a method; the Jacobs reference does not “anticipate” the claimed method. To be sure, if one knew to select the compounds of Appellants’ Formula I, having Appellants’ defined R groups, in Appellants’ method, then one would successfully carry out the claimed method; but one did not know, not from Sandvary and not from Jacobs, what particular compounds to select to secure a successful outcome. One could not even have known that *any* of the compounds would be suitable for the claimed method. It is this fatal uncertainty that the

court recognized in *In re Rinehart*, 531 F.2d 1048 (CCPA 1976) would overcome a *prima facie* showing of obviousness constructed with 20-20 hindsight.

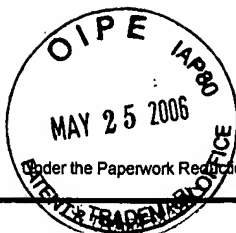
Conclusion

The present claims are patentable over the cited art. Applicants, therefore, respectfully petition this Honorable Board to reverse the final rejection of the claims on each ground and to indicate that all claims are allowable.

Respectfully submitted,


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May 25, 2006
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FORM**

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/734,979
	Filing Date	12/10/2003
	First Named Inventor	Campbell et al.
	Art Unit	1762
	Examiner Name	Turocy
Total Number of Pages in This Submission	Attorney Docket Number	0906S-000339 (IN-5567)

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature	<i>Anna M. Budde</i>				
Date	May 25, 2006				

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